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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,844	11/23/1998	GAD JANAY	030	1758

7590 03/01/2002

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EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/197,844	JANAY, GAD	
	Examiner	Art Unit	
	CESAR B PAULA	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on 11/23/98.

This action is made Non-final.

2. Claims 1-4 are pending in the case. Claim 1 is an independent claim.

The Examiner understands that this invention is directed towards the interception of data sent to a printer. This data is used to determine whether there is relevant information at a database. Newly found information is added to the data, if relevant information is found in the database.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 2 recites the limitation "copies of said document" in line 2. There is insufficient antecedent basis for this limitation in independent claim 1, because such "document" is not found in claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoda (Pat.# 5,890,173, 3/30/99, filed 11/20/96).

Regarding independent claim 1, Yoda discloses a "link information extraction unit" for intercepting document link data sent to a printer. This unit retrieves documents associated with the link data from a web database and prints both the intercepted link data (from a print storage) and the associated data received from the database (col.3, lines 10-40, and col. 5, lines 1-67). Yoda fails to explicitly disclose *a print spool*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the print spool, because Yoda teaches above the interception of a print job after the printing selection has been issued, and is awaiting to be printed.

Regarding claim 2, which depends on claim 1, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-40, and col.5, lines 52-col.7, line 67).

8. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoda in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

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Regarding claim 3, which depends on claim 1, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-40, and col.5, lines 52-col.7, line 67). Yoda fails to explicitly disclose *documents which are similar and differ only by certain information derived from a database look-up*. Ikenoue teaches the embedding of additional data about a document, retrieved from a database, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Yoda, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 4, which depends on claim 3, Yoda discloses the printing or generation of multiple pages of a document when only one page was ordered to be printed (col. 3, lines 1-40, and col.5, lines 52-col.7, line 67). Yoda fails to explicitly disclose *whether or not information is confidential*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Yoda, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Snelling (Pat. # 5,591,553), Tsumura (Pat. # 5,842,023), Satoh et al. (Pat. # 6,327,600), * Kuo (Pat. # 5,295,181), Vogel (Pat. # 5,388,194), Castro (Pat. # 6,014,228), Sanchez (Pat. # 6,118,546), Ohashi (Pat. # 6,209,030), and Feliciano et al. (Pat. # 6,052,730).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry)

Or:

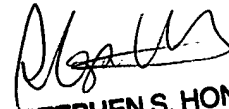
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- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label “PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

2/25/02


STEPHEN S. HONG
PRIMARY EXAMINER